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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,680	06/10/2005	Brian Douglas Chapman	DC5061 PCT 1	3661

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EXAMINER	
LOEWE, ROBERT S	
ART UNIT	**PAPER NUMBER**
1796	

NOTIFICATION DATE	DELIVERY MODE
02/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary	Application No.	Applicant(s)	
	10/538,680	CHAPMAN ET AL.	
	Examiner	Art Unit	
	Robert Loewe	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETALIED ACTION

Applicant's arguments/remarks, filed on 12/21/07, have been fully acknowledged.

Claim Objections

Claim 1 is objected to because formula (II) should contain a point of attachment to provide for clarity. Specifically, formula (II) should read "-$(Y_{3-n}R_nSiO_{1/2})_c(Y_{2-o}R_oSiO_{2/2})_d$..." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 and 8-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, formula (II) of instant claim 1 contains a (CR_qY_{1-q}) group. It appears that the carbon atom in this group has only three bonds. Appropriate correction is required.

Claim 4 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the limitation "x can range from 1 to 100" is vague and indefinite. The integer x **can** be from 1 to 100 but as written it does not have to be. It could be zero or a number greater than 100. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 6, 8, 10 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayoshi et al. (US 2002/0099114).

Claim 1: Nakayoshi et al. teaches a method (examples of Nakayoshi et al.) comprising (1) heating (paragraph 0109) in the presence of a catalyst (paragraphs 0086-0088), a mixture comprising (i) at least one organohydrogensilicon compound containing at least one silicon-bonded hydrogen atom per molecule which satisfies the structural limitations of formula (I) of instant claim 1 (paragraphs 0073-0078). Specifically, the top structure of paragraph 0076 shows a cyclic siloxane having three Si-H groups, four Si-Me groups, and one $Si\text{-}C_2H_4Si(OCH_3)_3$ group. This structure satisfies the limitation that R of formula (I) be equal to hydrogen and an alkyl group. This structure further satisfies the limitation that X may be equal to a $Z\text{-}R^4$ group, with Z being a divalent alkyl radical (ethylene) and R^4 being an $-SiR_vY_{3-v}$ group with v being equal to 0, and Y being an alkoxy group. The proviso that at least one X group of formula (I) be a $-Z\text{-}R^4$ group is met by Nakayoshi et al. Nakayoshi et al. further teaches an alkenyl-substituted polyorganosiloxane which satisfies the structural limitations of formula (IV) of instant claim 1 (paragraph 0064). Nakayoshi et al. further teaches that component (i) can be present such that an excess of Si-H groups to alkenyl groups results (paragraph 0025). This teaching satisfies the

limitation of instant claim 1 "to form silicon-bonded hydrogen containing branched polymers". Thus, Nakayoshi et al. anticipates the method of instant claim 1.

Claim 2: Nakayoshi et al. further teaches that b is an integer of 2 or 3 (paragraph 0076).

Claim 6: Nakayoshi et al. further teaches that R' is independently chosen from alkyl and alkenyl (paragraphs 0059-0066) and component (ii) is added between 3 and 1000 parts by weight based on 100 parts by weight of component (i) (paragraph 0025).

Claim 8: Nakayoshi et al. further teaches that component (i) is the reaction product obtained by mixing in the presence of a platinum group metal-containing catalyst at least one organohydrogensilicon compound containing at least one silicon-bonded hydrogen atom per molecule and at least one compound having at least one aliphatic unsaturation (paragraphs 0078-0080).

Claim 10: Nakayoshi et al. further teaches a silicon-bonded hydrogen containing branched polymer made by the method of claim 1 (paragraphs 0024-0027 and 0107).

Claim 12: Nakayoshi et al. further teaches a composition comprising the silicon-bonded hydrogen containing a branched polymer of claim 10 (paragraphs 0024-0027 and 0107).

Claim 13: Nakayoshi et al. further teaches a composition comprising the silicon-bonded hydrogen containing branched polymer of claim 10, a Si-alkenyl crosslinker, a platinum-group containing catalyst (paragraphs 0024-0027 and 0107), and an inhibitor (paragraph 0097).

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Asch et al. (US application 2006/0111491).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim 1: Asch et al. teaches a method of heating (paragraph 0101) in the presence of a catalyst (paragraph 0068-0069), a mixture comprising an organohydrogen silicon which satisfies the structural limitations of formula (I) of instant claim 1 (paragraphs 0008-0009) with an organopolysiloxane meeting the structural limitations of formula (IV) of instant claim 1 (paragraph 0035). It follows that the organopolysiloxanes taught by Asch et al. can inherently be used as endblocking materials. Asch et al. further teaches that components (i) and (ii) are polymerized to form silicon-boned hydrogen containing branched polymers (examples 1-18).

Claims 2-5: Asch et al. further teaches identical structures found in instant claims 2-5 (structures of paragraph 0063).

Claim 6: Asch et al. further teaches that component (ii) is added in amounts from 3 to 1000 parts by weight based on 100 parts by weight of component (i) (example 1).

Claim 8: Asch et al. further teaches that component (i) is the reaction product obtained by mixing in the presence of a platinum group metal-containing catalyst at least one organohydrogensilicon compound containing at least one silicon-bonded hydrogen atom per molecule and at least one compound having at least one aliphatic unsaturation (example 16).

Claim 9: Asch et al. further teaches the method of instant claim 1 which further comprises (2) mixing in the presence of a platinum group metal-containing catalyst, the silicon-bonded hydrogen containing branched polymers from step (1) with (iv) at least one material having at least one aliphatic unsaturation to form a branched polymer (examples 16-18).

Claim 10: Asch et al. further teaches silicon-bonded hydrogen containing branched polymer made by the method of instant claim 1 (examples 9-12).

Claim 11: Asch et al. further teaches a branched polymer made by the method of claim 9 (examples 16-18).

Claim 12: Asch et al. further teaches a composition comprising the silicon-bonded hydrogen containing branched polymer of instant claim 10 (paragraph 0137).

Claim 13: Asch et al. further teaches a composition comprising the silicon-bonded hydrogen containing branched polymer of instant claim 10, a Si-alkenyl crosslinker, a platinum-group containing catalyst, and an inhibitor (paragraph 0137).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 8-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 and 9-11 of copending Application No. 10/538,682. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 1 and claim 1 of copending application '682 both claim a method of heating in the presence of a catalyst components (i), (ii), and optionally (iii). There is nothing claimed which distinguishes the two copending applications until claim 8 of copending application '682 which claims that an excess of aliphatically unsaturated component is required to consume all of the Si-H groups. The instant application claims Si-H containing branched polymers, requiring a stoichiometric excess of Si-H groups to Si-alkenyl groups.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments regarding claims 1, 2, 6, 8, 10, 12 and 13 (Nakayoshi et al. US 2002/0099114) have been fully considered but they are not persuasive.

Applicants argue that the scope of Nakayoshi et al. is very different from the instant application. Specifically, Applicant's argue that Nakayoshi et al. does not teach the endblocking

materials of instant claim 1. It is believed, as described in the rejection above, that Nakayoshi et al. does indeed teach the addition of organopolysiloxanes which satisfy the structural limitations of formula (IV) of instant claim 1. It follows that these materials can inherently be used as endblocking materials. Further, Applicant's argue that the instant invention relies on an equilibrium type reaction between the SiH containing materials and the end-blockers resulting in a ring-opening reaction of the cyclic starting materials. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a ring-opening reaction of the endblocker) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, claim 1 is drawn to a method of heating in the presence of a catalyst, components (i) and (ii) (component (iii) is not considered since it is optional). Nakayoshi et al. teaches a method of heating in the presence of a catalyst, components (i) and (ii) which satisfy the structural limitations placed therein.

Applicant's arguments regarding claims 1-13 (Asch et al. US 2006-0111491) have been fully considered but they are not persuasive.

Applicants argue that Asch et al. does not teach the method and compositions of the instant invention. Specifically, Applicants argue that the instant invention relies on an equilibrium type reaction between the SiH containing materials and the end-blockers, resulting in a ring-opening reaction of the cyclic starting materials. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features

upon which applicant relies (i.e., a ring-opening reaction of the endblocker) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, claim 1 is drawn to a method of heating in the presence of a catalyst, components (i) and (ii) (component (iii) is not considered since it is optional). Asch et al. teaches a method of heating in the presence of a catalyst, components (i) and (ii) which satisfy the structural limitations placed therein.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RSL
17-Jan-08

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